

**THIS OPINION IS NOT  
CITABLE  
AS PRECEDENT OF  
THE TTAB**

Mailed: 2/26/04  
Paper No. 16  
ejs

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Andrea I. Weinstein

Serial No. 76280695

Myron Amer for Andrea I. Weinstein

Russ Herman, Trademark Examining Attorney, Law Office 108  
(David Shallant, Managing Attorney)

Before Seeherman, Bottorff and Rogers, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Andrea I. Weinstein has appealed from the final refusal of the Trademark Examining Attorney to register RETIREMENT REBATE PLAN for "providing rebates for online purchases made via a portal site comprised of participating retail establishments, such purchases providing for remittances to a retirement account with a participating broker or bank."<sup>1</sup> The application was initially filed on

---

<sup>1</sup> Serial No. 76280695.

July 8, 2001, seeking registration on the Principal Register, and asserting a bona fide intention to use the mark in commerce. After the Examining Attorney refused registration pursuant to Section 2(e)(1) of the Trademark Act, applicant, on January 22, 2002, submitted a specimen as well as a declaration stating that the mark was used in commerce as early as January 11, 2002 (treated by the Examining Attorney as an amendment to allege use), and amended her application to the Supplemental Register. In response to the Examining Attorney's requirement, she disclaimed exclusive rights to the words REBATE PLAN.

The Examining Attorney has issued a final refusal of registration on the basis that the specimen submitted by applicant on January 22, 2002 does not show use of the mark in connection with the identified services, and that the substitute specimen submitted by applicant on January 24, 2003, does not show use of the mark as of the filing of the amendment to allege use/amendment to the Supplemental Register.

The appeal has been fully briefed. Applicant did not request an oral hearing.

We affirm the refusal.

We first address a procedural point raised by applicant. Applicant contends that the Examining Attorney

is, in effect, estopped from raising a requirement for acceptable specimens because the Examining Attorney delayed in making this requirement. A review of the prosecution history shows that, after applicant amended her application to the Supplemental Register, the Examining Attorney issued an Office action, on November 1, 2002, in which he accepted the amendment, but required a disclaimer of REBATE PLAN and an acceptable identification of services. No objection to the specimens was raised at this time. Therefore, it is applicant's position that, when it complied with the stated requirements in the response filed on November 12, 2002, the application, "the prosecution of the application was in effect closed, and at law no open issues remained." Brief, p. 3. Applicant points to the statement made in the November 1, 2002 Office action that "Publication for opposition is deferred pending applicant's response to the above noted issues"<sup>2</sup> as further support for her position that prosecution had been completed. Therefore, applicant argues that the review that resulted in the December 26, 2002 Office action, ["on review of this application prior to issuance on the Supplemental Register it was noted that

---

<sup>2</sup> This statement is incorrect, in that applications for registration on the Supplemental Register do not undergo the publication procedure.

applicant's specimens do not show use of the mark in commerce"] was not in response to applicant's communication filed November 12, 2002. Applicant further states that the Examining Attorney's actions in raising this new requirement were prohibited by TMEP §1105.01, which applicant quotes as follows:

The examining attorney should leave no point of refusal or requirement necessary to secure correction or amendment for later action. Omission of a refusal or requirement would be piecemeal prosecution, which should be avoided whenever possible.

First it should be noted that Section 1105.01 does not contain the quote provided by applicant. However, applicant is correct that the Trademark Operation generally discourages piecemeal prosecution of applications. See, for example, Section 704.01, which includes the statement, "Every effort should be made to avoid piecemeal prosecution, because it prolongs the time needed to dispose of an application." However, Examining Attorneys are not prohibited from raising new issues or requirements in subsequent Office actions. In fact, several sections of the Trademark Manual of Examining Procedure discuss such an event. See, for example, Section 706, which states, *inter alia*:

If in the first Office action the examining attorney inadvertently failed to refuse registration on a clearly applicable ground or to make a necessary requirement, the examining attorney must take appropriate action to correct the inadvertent error in a subsequent action.

\*\*\*

...an examining attorney who does make a new refusal or requirement should clearly explain why the refusal or requirement is necessary, and apologize for the delay in raising the issue, if appropriate.

See also, Section 711.02.

Although it is unfortunate that the Examining Attorney did not determine that the specimen submitted with applicant's amendment to allege use was not acceptable until the second Office action considering this amendment and the amendment to the Supplemental Register, and not until after applicant had responded to the requirements for a disclaimer and an amendment to the identification, the Examining Attorney was not prohibited from requiring acceptable specimens in that Office action. The mandate of the USPTO is to register only registrable marks, and when an application and specimen do not show use of the applied-for mark for the identified services, the mark is not registrable, and any delay by the Examining Attorney in raising this objection can have no effect on our decision herein.

This brings us to the substantive basis for refusal, namely, that applicant has not provided acceptable specimens showing use of the mark.

With respect to the original specimen, which applicant submitted on January 22, 2002, it is the Examining Attorney's position that this specimen does not evidence use of the mark for the identified services. Applicant has not addressed the adequacy of this specimen in her brief, instead relying only on the estoppel argument discussed above. Therefore, it appears that applicant is no longer asserting that this specimen is acceptable. However, in order to be perfectly clear, we specifically find that this specimen is unacceptable to show use of the mark for the identified services.

Trademark Rule 2.56 provides, *inter alia*, that:

(a) An application under section 1(a) of the Act, an amendment to allege use under §2.76, and a statement of use under §2.88 must each include one specimen showing the mark as used on or in connection with the goods, or in the sale or advertising of the services in commerce.

\*\*\*

(b)(2) A service mark specimen must show the mark as actually used in the sale or advertising of the services.

Section 45 of the Trademark Act, 15 U.S.C. 1127, defines "use in commerce" as follows:

*Use in commerce.* The term "use in commerce" means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this Act, a mark shall be deemed to be in use in commerce—

\*\*\*

(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

Applicant's original specimen is a twenty-page document which bears, on the title page, the words "Commitment, Inc. Business Plan." The body of the report is clearly a business plan, stating, inter alia:

Notice to Potential Lenders and Investors  
Every effort has been made to give potential lenders, investors and other readers of this document a fair and accurate picture of Commitment, Inc., and the environment in which we work.  
(p. 19)

Commitment makes no warranty, express or implied, with regard to the successful implementation of this plan, or any part of this plan, or with regard to the future growth of revenue or earnings. (p. 20)

The words RETIREMENT REBATE PLAN do appear in this business plan, e.g.:

Commitment is the world's largest portal site for women, with a first ever Retirement Rebate Plan™ that will give millions of women rebates on products they buy from our retail partners that will be put into tax-free retirement savings accounts, which will be handled by a major U.S. investment firm. (p. 2).

However, it is not enough that applicant has simply used the term RETIREMENT REBATE PLAN in any type of literature which she may distribute; the Statute specifically prohibits the reserving of rights in a mark. Applicant must use the mark in connection with the sale or advertising of her identified services, and in a manner which will identify to consumers that this is a trademark for the services. It is well settled that an applicant must have used the mark to identify the named services for which registration is sought. In re Advertising & Marketing, 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987), citing In re Universal Oil Prods. Co., 476 F.2d 653, 177 USPQ 456 (CCPA 1973).

Applicant's use of RETIREMENT REBATE PLAN, as shown in the identified specimen, is not in connection with the sale or advertising of the service of providing rebates for online purchases. It is not even clear from the specimen that applicant currently even renders such a service, or whether this is a planned service that will be offered at



the time she gets the necessary funding. What is clear is that the business plan is not directed to or intended to be viewed by consumers of the services.

Applicant also submitted a substitute specimen with her request for reconsideration, filed March 13, 2003. This specimen consists of a cover letter dated March 5, 2003, which refers to enclosed information, but which information was not provided. It includes a paragraph stating "Our Retirement Rebate Plan™ allows women to save for retirement when they purchase products from our site they already buy, such as books, toys, care, CDs, clothes, flowers, and give [sic, should be gift] certificates." This letter is signed by applicant, and is written on the letterhead of the law firm of Schonfeld & Weinstein, L.L.P. at which applicant appears to be a partner. Although in the Office action considering this specimen the Examining Attorney indicated certain problems as to the letter's failure to show use of the mark in commerce for the sale or advertising of services, in his brief he confined his comments to the date the specimen was in use. Accordingly, we will do the same.

As noted, the letter is dated March 5, 2003, and as such does not evidence service mark use of RETIREMENT REBATE PLAN prior to that date. However, applicant's

amendment to allege use and amendment to the Supplemental Register was filed on January 22, 2002. Thus, this substitute specimen does not evidence use of the mark at the time the amendment to allege use and the amendment to the Supplemental Register were submitted.

Applicant asserts that no amendment to allege use was made or required to be made because the "the application was filed under Sec. 1(a) and converted to one based on actual use during the prosecution of the application pursuant to C.F.R. §2.76 [sic, should be 37 C.F.R. §2.76]. Brief, p. 4.

Applicant's statement has an internal inconsistency. An application filed under Section 1(a) of the Trademark Act is based on use in commerce, and need not be converted to a use-based application. Applicant's original application was based on Section 1(b) of the Statute, in that it asserted a bona fide intention to use the mark in commerce. As noted above, the Examining Attorney treated the declaration which was filed on January 22, 2002, in connection with the original specimen, as an amendment to allege use. Further, applicant could not have amended her application to the Supplemental Register at that time without the amendment to allege use; Section 23 of the Act clearly requires that to be eligible for registration on

the Supplemental Register, the mark must be in use in commerce.

Thus, applicant must show that her mark was in use as of the filing of the amendment to allege use and the amendment to the Supplemental Register on January 22, 2002; clearly, the substitute specimen, which is dated March 5, 2003, does not evidence use as of that time.

Decision: The refusal of registration on the basis of the unacceptability of applicant's specimens is affirmed.